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ALEXANDRIA, VA 22304

In re Application of:

Christensen, Scott N.
Application No. 09/315,822
Filed: May 21, 1999
For: VIRTUAL COUPONING METHOD AND
APPARATUS FOR USE WITH CONSUMER
KIOSK

**DECISION ON PETITION
UNDER 37 CFR 1.181**

This is in response to the June 7, 2010 Request for Reconsideration of the Decision on Petition under 37 CFR 1.181.

The petition is **GRANTED**.

A petition under 37 CFR 1.181 requesting that an Office action mailed January 8, 2010 be vacated was received on May 7, 2010. The petition was dismissed as moot in a decision mailed June 1, 2010 since a Notice of Allowability was mailed May 24, 2010.

Petitioner requests reconsideration of the dismissal. Petitioner argues that the term of the patent depends upon grant or denial of the May 7, 2010 petition and that "the petition is not moot because its grant or denial affects substantive rights; the length of the term of the resulting patent." Petitioner's request for reconsideration is granted.

A review of the prosecution history shows that applicant appealed the rejection of claims 1, 4, 9-16 and 24-27 under 35 USC 102(b) as being anticipated by Lemon, the rejection of claims 16-26 under 35 USC 102(e) as being anticipated by Powell, and the rejection of claims 1-16, 19 and 24-27 under 35 USC 103(a) as being unpatentable over Barnett. In the Decision on Appeal mailed July 30, 2009, the Board of Patent Appeals and Interference sustained the 35 USC 102(b) rejection of claims 1, 9-16, 24, 27, the 35 USC 102(e) rejection of claims 16-26, and 35 USC 103(a) rejection of claims 1-3, 5-11, 13-15, 16, 19 and 24-27. The examiner's rejection of claim 4 under 35 USC 102(b) and of claims 4 and 12 under 35 USC 103(a) were not sustained. Pursuant to MPEP 1214.06, applicant filed an amendment after the Board decision cancelling claims 1, 11 and 16-26 and amending claims 2-4, 12-14 and 27. Applicant requested entry of the amendment because "dependent claim 4 (for which the Board has reversed all rejections) has been rewritten in independent form." In response to applicant's amendment, the examiner issued the January 8, 2010 non-final Office action.

In the May 7, 2010 petition, petitioner argues that the January 8, 2010 Office action was mailed contrary to U.S. Patent and Trademark policy in that it was not authorized by the Technology Center (TC) Director. Accordingly, the Office action should be vacated.

According to MPEP 1214.04, the examiner should never regard a reversal of the examiner's rejection as a challenge to make a new search to uncover other and better references. If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner is reversed, the examiner should submit the matter to the TC Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new grounds of rejection. The TC Director's approval is placed on the action reopening prosecution.

A review of the January 8, 2010 Office action shows that the examiner rejected all the claims under 35 USC 103(a) using the same references under appeal (i.e., Lemon and Barnett). The examiner also used Official notice in rejecting the claims. Accordingly, the examiner did not have specific knowledge of the existence of a particular reference which would warrant the reopening of prosecution. Furthermore, the lack of a TC Director's signature on the January 8, 2010 Office action indicates that the examiner did not have the TC Director's approval to reopen prosecution. Since the examiner failed to follow Office policy, as set forth in MPEP 1214.04, the Office action mailed January 8, 2010 is hereby vacated.

Inquiries regarding this communication should be directed to Teri P. Luu, Quality Assurance Specialist, at (571) 272-7045



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WC/tl: 06/25/10

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